UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,171	02/11/2004	John V. Bernardi	OMG/168/US	1006

2543 7590 03/11/2009

ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD, CT 06103

EXAMINER	
NGUYEN, CHI Q	
ART UNIT	PAPER NUMBER
3635	

MAIL DATE	DELIVERY MODE
03/11/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/775,171	BERNARDI ET AL.	
	Examiner	Art Unit	
	CHI Q. NGUYEN	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-12 and 14-36* is/are pending in the application.

4a) Of the above claim(s) *8-12,14,15 and 20-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-7,16-19 and 25-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to applicant's amendment filed on 1/5/2009.

Status of Claims

Claims 2-7, 16-19 and 25-36 are pending.

Claims 8-12, 14-15 and 20-24 have been withdrawn.

Claims 1 and 13 have been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 25-30, 2-7, 16-19 and 31-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,382,353 to Kelly in view of US Pat. No. 4,787,188 to Murphy.

Claims 25 and 27: Kelly discloses an assembly of reverse furring technique comprising: a substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said

oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate. Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking substructure, will likewise be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind.

Claim 26: Wherein said substrate comprises a structure selected from the group comprising a suitable metal sheet strip (col. 2, line 24).

Claims 28 and 5: Wherein said substrate comprises a flattened tubular member and said plurality of seam plates are fixedly secured within said tubular member by means of adhesive material (see col. 2, line 49. Note that the limitation of "heat-sealed" would have been considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 29-30: Kelly in view of Murphy disclose the basic structures for the roofing structures as stated but do not disclose expressly wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be rolled into a coiled form and wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be folded in a pleated array in order to permit said seam plates to be stacked in a nested array with respect to each other. A term "fabricated" would have been considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 2-3: Kelly discloses the basic structures for a roofing assembly and further wherein when the underlying roof decking substructure comprises a corrugated 3 or non- corrugated 1 roof decking substructure, comprising a plurality of crest portions 5 spaced from each other by means of predetermined distances but does not disclose a plurality of seam plates are fixedly mounted upon said substrate at predeterminedly spaced positions which correspond to the predetermined distances defined between the

plurality of spaced crest portions of the underlying corrugated roof decking substructure so as to ensure said plurality of seam plates can be fixedly secured to the plurality of spaced crest portions of the underlying corrugated roof decking substructure. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc.

Claims 4 and 6-7: Kelly discloses the basic structures for a roofing assembly as stated but does not disclose expressly wherein each one of said plurality of seam plates has a plurality of projections extending downwardly from undersurface portions of each one of said plurality of seam plates for engaging each one of the environmental membranes and said substrate has a substantially C-shaped cross-sectional configuration comprising an upper planar member disposed atop said plurality of seam plates and a pair of lower planar flap-type members folded inwardly from opposite side edge portions of said upper planar member. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having a plurality of projections or prongs 21 (see Fig. 3, col. 2, line 7) extending downwardly from undersurface portion of each one of said plurality of seam plate (see Figs. 1-2) and opening 15 for receiving an appropriate fastening means such as screws

(see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc. Kelly in view of Murphy disclose the basic structures for a roofing assembly as stated but do not disclose the substrate has a substantially C-shape cress sectional configuration. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a C-shaped cross sectional substrate for desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 31: Kelly discloses an assembly of reverse furring technique comprising: an underlying roof decking substructure 3, an insulation panel 7 disposed atop said roof decking substructure, a plurality of environmental membranes 19 adapted to be fixedly / secured atop said insulation panel 7, at least one substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal

extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate. Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking substructure, will be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind.

Claim 32: see rejections of claim 26 above.

Claim 33: wherein said substrate 11 comprises at least a pair of substrates fixedly connected together along at least one longitudinally extending seam portion (Fig. 1).

Claim 34 and 17: see rejections of claims 28, 5, above.

Claims 35-36: see rejections of claims 29-30 above.

Claims 16 and 18-19: see rejections of claims 4, 6-7, above.

Response to Arguments

Applicant argues that the prior arts Kelly and Murphy do not disclose "said seam plates being affixed to said substrate independently of the fasteners" and the additional feature that "said plurality of seam plates are disposed ...at predeterminedly spaced positions along said longitudinal extent of said substrate so as to define with said substrate an integral product entity such that when said first seam plate of said plurality of seam plates is fixedly secured at a first location along the underlying roof decking substructure by means of a fastener, the remaining seam plates of said plurality of seam plates, fixedly attached to said substrate at predetermined positions along the longitudinal extent of the said substrate, will inherently be disposed at pre-determined locations along the underlying roof decking substructure" the arguments have fully considered but they are not persuasive because: (1) the argued limitation "said seam plates being affixed to said substrate independently of the fastener" is contradicted to the claimed preamble (claim 25) "As assembly for facilitating a fixed mounting of roof membrane seam plates at predetermined locations upon an underlying roof decking substructure by means of fasteners, comprising:" (see also claim 31) the applicant has been contradicted himself because the applicant's claimed invention would need some kinds of fastener means for securing roofing membranes; (2) Kelly is clearly shows in Fig. 1 for a plurality of predeterminedly spaced position along the longitudinal extend of the substrate for possibly fasteners and the seam plates, which taught Murphy for a stronger securement roofing membranes.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pairdirect.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at (866) 217-9197.

/C. Q. N./
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635